

REMARKS

This Reply is responsive to the Office Action of December 11, 2007. Claims 1-4 were previously pending in the application. The Office Action rejects Claims 1 and 3-4 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,797,515 to Liff et al. ("the Liff reference"). The Office Action rejects Claim 2 under 35 U.S.C. § 103(a) as being unpatentable over the Liff reference in view of U.S. Patent No. 6,112,502 to Frederick et al. ("the Frederick reference"). In light of the following remarks, Applicants request reconsideration of the present application and allowance of the current set of claims.

Claim Rejections under 35 U.S.C. §102(b) and 35 U.S.C. §103(a)

Claims 1 and 3-4 currently stand rejected under 35 U.S.C. § 102(b). Claim 2 stands rejected under 35 U.S.C. § 103(a). With respect to these rejections, Applicant respectfully traverses.

A. The rejections under 35 U.S.C. §102(b) and 35 U.S.C. §103(a) are improper

Applicants respectfully submit that the current rejection of independent Claim 1 is improper since, in order to anticipate a claim, the reference must teach every element of the claim. However, the Liff reference has not even been asserted to teach every element of independent Claim 1. As stated in MPEP 2131, citing the patent laws, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). In the present situation, not only does the Liff reference fail to teach or suggest the claimed features regarding a handheld device programmed to receive order quantity information associated with the read indicia for a decentralized storage location, a workstation configured to receive a current quantity of said item stored in a centralized storage location, and a computing device configured to receive the transferred information and queue a restocking package to be processed for the decentralized storage location in response to the transferred information, (emphasis added), but the Office

Action fails to even assert that such elements are expressly or inherently disclosed by the Liff Reference. Additionally, the Office Action refers to elements of Claim 1 that had been previously amended out of the claim language in the Preliminary Amendment filed on October 31, 2007. In fact, the Office Action appears to repeat, verbatim, the rejections issued in the Final Rejection of November 27, 2006 and does not address the amended language of independent Claim 1 made in the previous amendment. Accordingly, in the present case, given that the Office Action fails to assert that the Liff reference discloses the above recited features and that no rationale or evidence showing inherency of these features has been set forth in the Office Action, the rejection of independent Claim 1 based on anticipation in view of the Liff reference is improper.

As such, Applicant has seasonably challenged whether the cited reference teaches or suggests at least one of the features for which no explanation as to how the cited reference teaches or suggests the corresponding feature (e.g., the features regarding a handheld device programmed to receive order quantity information associated with the read indicia for a decentralized storage location, a workstation configured to receive a current quantity of said item stored in a centralized storage location, and a computing device configured to receive the transferred information and queue a restocking package to be processed for the decentralized storage location in response to the transferred information). Applicant again seasonably challenges the assertion that these features are disclosed in the Liff reference and requests an explanation as to how such features are taught or suggested by the Liff reference.

Because dependent Claim 2 includes each of the claim recitations of independent Claim 1, from which it depends, and for at least the same reasons as above, Applicants also submit that the current rejection of Claim 2 is improper.

B. Claims 1-4 are patentable over the cited references

Notwithstanding the impropriety of the current rejections, Applicants further submit that the cited references fail to teach or suggest the features of independent Claim 1. In this regard, for example, independent claim 1 recites, *inter alia*, a plurality of open shelves containing bins for carrying items, said items having indicia associated therewith; a handheld device

programmed to: read the indicia associated with an item for which a restock is desired, receive order quantity information associated with the read indicia for a decentralized storage location, and transfer the information associated with the read indicia and the order quantity information to enable a restocking package to be prepared; a workstation configured to receive a current quantity of said item stored in a centralized storage location; and a computing device configured to receive the transferred information and queue a restocking package to be processed for the decentralized storage location in response to the transferred information. (Emphasis added). Applicants submit that neither the Liff reference nor the Frederick reference, alone or in combination, teaches or suggests the elements of independent Claim 1, as previously amended.

The Liff reference discloses (referring to **Fig. 1**, for example) a system for dispensing pharmaceuticals that includes a cabinet **20**, a host computer **46**, and bar code reader **40**, which may comprise a hand-held bar code reader unit **41**. See col. 5, lines 8-18; col. 6, lines 45-46. The cabinet **20** includes columns **34** that may be loaded with pharmaceutical packages **32**. Before a column **34** is loaded with a package **32**, a column bar code label **76** is compared with a bar code label **76** on the package **32**. This comparison may take place visually as the reference does not explicitly teach or suggest scanning either the package bar code label or the column bar code label to perform the comparison. See col. 6, lines 45-67. During loading, the packages **32** are loaded up to a certain height designated by a column label **75**. The Liff reference then teaches scanning the package bar code label as each package is dispensed. See col. 6, lines 51-54. However, the Liff reference does not teach or suggest a handheld device programmed to receive order quantity information associated with read indicia for a decentralized storage location; a workstation configured to receive a current quantity of said item stored in a centralized storage location; or a computing device configured to queue a restocking package to be processed for the decentralized storage location in response to the transferred information, as recited in independent Claim 1.

The Frederick reference, which is cited in the Office Action with regard to the rejection of Claim 2, discloses a method for monitoring, dispensing, and restocking medical items from a plurality of storage locations. Each storage location of the Frederick reference is marked with a desired level or quantity for the item contained therein. Each storage location is further marked

with one or more scannable indicia (e.g., bar code labels) corresponding to a “quantity condition.” For example, one scannable indicium may correspond to a “below par level” condition, while another indicium may correspond to an “out of stock” condition. A user of the system determines whether an item requires restocking, such as by determining if the current quantity of the item is below the indicated par level or if the item is out of stock. The user then scans the appropriate indicium, corresponding to the determined quantity condition, using a handheld device. This causes the transmission of a message indicating that the particular storage location requires restocking. A data store may also include data representative of the number of units remaining in each storage location. However, the Frederick reference does not teach or suggest a handheld device programmed to receive order quantity information associated with the read indicia for a decentralized storage location; a workstation configured to receive a current quantity of said item stored in a centralized storage location; or a computing device configured to queue a restocking package to be processed for the decentralized storage location in response to the transferred information, as recited in independent Claim 1 and thus incorporated into dependent Claim 2.

Because neither the Liff reference nor the Frederick reference teaches or suggests the claim elements of independent Claim 1, Applicants submit that the rejections of independent Claim 1, as well as dependent Claims 3-4, are traversed. Additionally, because Claim 2 depends from Claim 1, Applicants submit that the rejection of dependent Claim 2 under 35 U.S.C. §103(a) is also traversed.

In view of the remarks presented above, Applicants respectfully submit that Claims 1-4 are patentable over the cited references, alone or in combination. As such, all of the present claims of the present application are in condition for immediate allowance.

Appl. No.: 10/820,213
Reply Dated March 10, 2008
Reply to Office Action of December 11, 2007

CONCLUSION

In view of the remarks presented above, it is respectfully submitted that the rejections of Claims 1-4 should be withdrawn. As such, all of the present claims of the present application are in condition for immediate allowance. It is therefore respectfully requested that a Notice of Allowance be issued. The Examiner is encouraged to contact Applicants' undersigned attorney to resolve any remaining issues in order to expedite examination of the present application.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



R. Flynn Streat
Registration No. 56,450

Customer No. 00826
ALSTON & BIRD LLP
Bank of America Plaza
101 South Tryon Street, Suite 4000
Charlotte, NC 28280-4000
Tel Charlotte Office (704) 444-1000
Fax Charlotte Office (704) 444-1111
CLT01#4803313v1

ELECTRONICALLY FILED USING THE EFS-WEB ELECTRONIC FILING SYSTEM OF THE UNITED STATES PATENT & TRADEMARK OFFICE ON March 10, 2008.